

REMARKS

Status of the Claims

Claims 2-6 are currently pending in the application. Claims 2-6 stand rejected. Claims 5 and 6 have been amended as set forth herein. All amendments are made without prejudice or disclaimer. No new matter has been added by way of the present amendments. Specifically, the amendments to claims 5 and 6 are directed at clarifying the amount of ash content in the surface layer of the wrapper paper is based on a percentage of the total ash content in the paper and is supported by the specification at page 12, line 11 to page 13, line 19, referring to the ash content in percentages. This is a non-narrowing amendment. Reconsideration is respectfully requested.

Rejections Under 35 U.S.C. § 103(a)

Claims 2-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamazaki et al., EP 0791688 (hereinafter referred to as “Yamazaki et al.”). (*See*, Office Action of May 8, 2006, at page 2, hereinafter referred to as “Office Action”). Applicants traverse the rejection as hereinafter set forth.

The Examiner states that Yamazaki et al. do not specifically state that an ash content in a surface layer on at least one side of the wrapper paper, or on each of a top side and a bottom side of the wrapper paper, is not higher than 35% by mass. (*Id.*). Furthermore, the Examiner states that the reference does not specifically state that the ash content in the surface layer is lower than a total ash content of the paper. (*Id.* at page 3).

The Examiner seems to be interpreting the “ash content” recited in claims 5 and 6 to be an absolute amount, not a relative amount. In the wrapper paper of the presently claimed

invention, the amount of ash in the surface layer is smaller than that in the central portion. The wrapper paper of the presently claimed invention can be prepared by a method as described in the present specification at, for instance, page 10, lines 8-20.

To further clarify the presently claimed invention, and in an effort to expedite prosecution, claims 5 and 6 have been amended to recite, in part, that “wherein the percentage of ash content in the surface layer is lower than a total percentage of ash content of the paper.” This is a non-narrowing amendment. The amendment simply clarifies that the amount of ash content in the surface layer of the wrapper paper is determined, according to the presently claimed method, relative to the total amount of ash content in the wrapper paper.

Yamazaki et al. do not disclose or suggest this element of the presently claimed method. Thus, since Yamazaki et al. do not disclose or suggest each and every limitation of the presently claimed invention, the disclosure of Yamazaki et al. cannot support a *prima facie* case of obviousness with respect to the presently claimed invention. (See, M.P.E.P. § 2143.03, stating that to “establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art,” *see also, In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)).

Since no independent reasoning is provided for the rejection of dependent claims 2-4, dependent claims 2-4 are non-obvious, *inter alia*, as depending from a non-obvious base claims, claims 5 and 6.

Reconsideration and withdrawal of the obviousness rejection of claims 2-6 are respectfully requested.

ENTRY OF AMENDMENTS

The amendments to claims 5 and 6 should be entered by the Examiner because the amendments are supported by the as-filed specification and do not add any new matter to the application. Additionally, the amendments should be entered since they comply with requirements as to form, and place the application in condition for allowance. Further, the amendments do not raise new issues or require a further search since the amendments incorporate elements from dependent claims into independent claims and/or are supported by the as-filed specification. Finally, if the Examiner determines that the amendments do not place the application in condition for allowance, entry is respectfully requested since they certainly remove issues for appeal.

If the Examiner has any questions or comments, please contact Thomas J. Siepmann, Ph.D., Registration No 57,374 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

Gerald M. Murphy, Jr.

Registration No.: 28,977

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicants